

Remarks

The Office has made final the Restriction Requirement made in Paper No. 10. Claims 94-111 are pending, however claims 96-102 were withdrawn from consideration. Applicants are canceling these non-elected claims herein, without prejudice to further prosecution of the subject matter in a divisional application.

Claims 94-95 and 103-111 have been examined on the merits. Claims 94, 103 and 108 are objected to for containing abbreviations undefined in the claims. Applicants have amended these claims as requested by the Examiner.

Claim 110 is rejected as indefinite under 35 U.S.C. §112, second paragraph. Applicants are canceling claim 110 herein without prejudice. Applicants therefore submit that this rejection is moot and request its withdrawal.

Claims 94 and 104-110 are rejected under 35 U.S.C. §112, first paragraph, on grounds of lack of sufficient written description. The Office asserts that the specification does not describe the genus of SXR target genes and reporter genes that are regulated by functional association of the ligand binding domain of SXR with an SXR coactivator, in such a manner as to show possession of the claimed genus.

Applicants traverse this rejection. The specification identifies at least *mdr1*, *cyp3a4* and *cyp2C8* as SXR target genes. Applicants refer the Office to Synold et al., Nat. Med. 7(5):584-590, 2001, which is incorporated by reference in its entirety on page 9 of the specification. This reference is of record in this case, however a copy is enclosed for the convenience of the Examiner. The reference discusses the network of xenobiotic clearance genes in the liver and intestine that are regulated by SXR. Applicants submit that this is more than ample disclosure to indicate to a skilled person that the inventors had possession

of the claimed invention. See p. 589, col 1 and the reference as a whole. Applicants submit that the three specifically disclosed genes sufficiently represent the family of SXR target genes, particularly with the guidance provided by the specification here and the reference incorporated therein.

Applicants are amending claim 94 at the present time, in order to advance prosecution, without prejudice to reinstating this subject matter in a later filed continuation or divisional application. Claim 94 now recites the two SXR target genes identified by the Office. Applicants therefore request that the Office withdraw the rejection made on grounds of lack of written description.

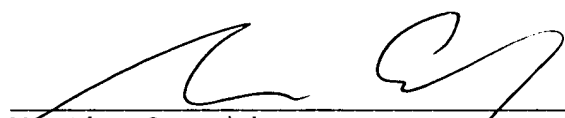
Claim 110 is rejected under 35 U.S.C. §102(e) as anticipated by Shtil. This claim is canceled herein, making this rejection moot. Applicants therefore request its withdrawal.

Finally, Applicants note that while the Office Action Summary states that no claim is allowed, claims 95, 103 and 111 have not been rejected on any grounds. Applicants therefore request formal acknowledgment of the allowance of these claims.

Applicants request favorable consideration of all of the claims as amended and allowance of the application.

Respectfully submitted,

By



Martha Cassidy
Attorney for Applicants
Registration No. 44,066
ROTHWELL, FIGG, ERNST & MANBECK, p.c.
Suite 800, 1425 K Street, N.W.
Washington, D.C. 20005
Telephone: (202) 783-6040